

REMARKS

Claims 1 - 18 are pending in this patent application. Claims 19 and 20 were canceled by preliminary amendment dated April 20, 2006. No claim previously presented is currently amended.

Claim 21 has been added to clarify that the generating unit and the display unit the execute control related to an incoming signal or the like when the incoming signal or the like is received. It is believed that this structure is not disclosed by the cited references. Thus, it is asserted that this response contains no new matter. It is further asserted that these remarks and amendments are fully responsive to the outstanding office action dated February 4, 2008.

The Examiner has required a new, more descriptive title. The applicant has thus amended the title of the invention so as to comply with the Examiner's requirement. The applicant requests that the amended title be approved by the Examiner.

Regarding the Specification, the Examiner has requested corrections of informalities listed in the outstanding action. The specification has been amended to correct these informalities, and it is requested that these objections be withdrawn in light thereof.

As to the merits of the outstanding action, the Applicants hereby submit the following remarks for the Examiner's consideration.

Claims 15 through 18 stand rejected under 35 U.S.C. § 101 for the reasons set forth in item 4 on page 3 of the outstanding action. The Applicants respectfully request reconsideration of this rejection.

The Court of Appeals for the Federal Circuit, in the case of *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), suggested that almost any unobvious software-related invention is patentable if the claims are properly drawn. In *State Street Bank* case, the patent at issue (U.S. Patent No. 5,193,056), is generally directed to a data processing system for implementing an investment structure dealing with the administration and accounting of mutual stock funds.

The court held that the transformation of data in a software-related patent (*e.g.*, in the *State Street Bank* case, which represented “discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price”) constitutes:

- (a) a “practical application of a mathematical algorithm, formula, or calculation,” but
- (b) nevertheless, produces “a useful, concrete and tangible result.”

In the instant case, the claimed display method, as set forth in each of claims 15 - 18, provides, among other “useful, concrete and tangible result[s],” the receiving of a video signal and the displaying thereof on a screen.

Further, MPEP 2106, for which the Examiner cites in rejecting Claims 15 - 18 clearly refers to the *State Street Bank* and *AT&T* for the proposition that which classification an invention falls into is irrelevant as to its patentability. MPEP 2106 states that, “The scope of 35 U.S.C. § 101 is the same regardless of the form or category of invention in which a

particular claim is drafted.” (*citing AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357 (Fed. Cir. 1999)). This section also refers to *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998) wherein the Federal Circuit explained that so long as the invention falls into at least one category of statutory subject matter, what is relevant for Section 101 is its “essential characteristics”, particularly “its practical utility.”

The practical utility of the claimed program is to transform incoming data based upon other instructions generated by the user and/or the incoming data.

Further in MPEP 2106.01, under the heading “FUNCTIONAL DESCRIPTIVE MATERIAL: “DATA STRUCTURES” REPRESENTING DESCRIPTIVE MATERIAL PER SE OR COMPUTER PROGRAMS REPRESENTING COMPUTER LISTINGS *PER SE*”, the MPEP clearly states that a computer program may be part of a valid claim. While data structures not attached to a physical medium are treated by the USPTO as unpatentable under Section 101, it is respectfully asserted that the instant claims refer to what amounts to a process acting upon display data, not to mere “data structures.” MPEP 2106.01 clearly states that whether a computer program is part of a “computerized process”, or it is part of a machine or manufacture, “the claim remains statutory irrespective of the fact that a computer program is included in the claim.” (*emphasis added*).

A computer-readable medium is present in each claim through the preamble of Claim 15 that states that the claims are towards “[a] computer program applied in a mobile phone . . .”. “When a computer program is recited in conjunction with a physical structure, such as a

computer memory, USPTO personnel should treat the claim as a product claim. “ MPEP 2106.01.

Claims 15 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by **Bum** (US 2003/0013417 A1). The Applicants respectfully request reconsideration of this rejection.

For a patent claim to be anticipated under 35 U.S.C. 102, each and every element as set forth in the claim must be found, either expressly or inherently, in a single prior art reference. *SRI International, Inc. v. Internet Security Systems*, 511 F.3d 1186, 1192 (Fed. Cir. 2008). The **Bum** disclosure does not disclose each and every limitation contained in Claims 15 and 17, and thus it is asserted that Section 102 does not bar patentability of these claims in view of **Bum**.

Claim 15 and **Bum** differ for two main reasons.

First, **Bum** does not disclose streaming data. Instead, the reference merely suggests downloading video data to a storage device within the mobile phone ([0005]). A user will then view the video on the phone from the phone's storage device.

Second, the reference does not disclose displaying data from an incoming call. In fact, the description does not mention this part at all.

As to Claim 17, beyond the applicable discussion of Claim 15 above, the **Bum** reference does disclose detecting a prescribed operation by the user whereby the video will be scaled/rotated (*See Abstract*)

However, the mechanism for performing this task in **Bum** is purely mechanical in nature. (*See*, e.g., [0025] and [0027]) The method in the present application involves a computer controlled system whereby a microprocessor will take in data concerning the actual position of the entire device, not just the relative position of the display to the base of the phone (with the key pad). Because **Bum** does not disclose a user inputting a signal to a microprocessor, or an incoming signal, to rotate/scale the video signal being produced on the display, but instead discloses rotation of the display relative to the base, as read by mechanical means send a signal to rotate the display, the **Bum** application does not articulate each and every limitation contained within Claim 17.

The rejections of Claims 1 through 17 under 35 U.S.C. § 103(a) in the present office action rely on a combination of **Bum** in view of **Mizuta et al.** (US Patent Application Publication 2003/0064758 A1). The Applicants respectfully request reconsideration of these rejections.

Mizuta et al. discloses a foldable portable information terminal. Each grouping of rejections will be discussed in turn.

Regarding Claims 1 and 11, the **Bum** application does not disclose receiving an incoming video signal for direct transmission unto the phone display. Nowhere within the **Bum** description is this found. Instead, the **Bum** description merely speaks of downloading

video data to a storage medium, and then later recalling the video from the medium for display on the mobile device.

However, Bum does disclose displaying video in a first display area and display information in a second display area.

Mizuta et al. discloses displaying video and display information respectively in first and second display areas.

However, the disclosure of Mizuta et al., in Paragraph 118 and Figure 10b, suggests displaying the display information in only in an area of the display which is not being used by the video signal. Paragraph 118 of Mizuta et al. application explicitly states that only when the video signal is rotated (such that the portions of the display are not being utilized for the video signal) that the display information will be shown on the display. What the combination of Bum and Mizuta et al. does not disclose is downscaling the video (originally occupying the entire display area) to a first display area and then showing the display information in a second display area. The second area is obtained from the area not utilized due to the downscaling of the video. This is a key distinction between the prior art and the claimed invention.

Because the combination of Bum and Mizuta et al. does not disclose each element of Claims 1 and 11, nor would a person of ordinary skill in the art be able to combine those references to develop a device of Claim 1 or a method of Claim 11, the applicant respectfully requests that the Section 103 rejection as to Claims 1 and 11 be withdrawn.

Further, because Claims 2, 4, 5, 7, 8, and 9 depend from Claim 1, and Claims 12, 13, and 16 depend from Claim 11, it is believed that the above arguments to the independent claims are sufficient to render the dependent claims also nonobvious. As such claims Claims 2, 4, 5, 7, 8, 9, 12, 13, and 16 are also believed to be in condition for allowance, and withdrawal of the outstanding Section 103(a) rejections is hereby respectfully requested.

Claims 3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Bum** in view of **Mizuta et al.** in further view of **Kishimoto et al.** (U.S. Patent Publication No. 2002/0094846 A1).

Kishimoto et al. discloses a portable information apparatus whereby the information projected onto its display are only displayed in the portion of the screen necessary, creating image and non-image portions of the display. **Kishimoto et al.** also disclose displaying two separate information images within a single display. However, this reference does not disclose viewing one signal, and then either rotating or scaling displayed video so that information from another signal may be disclosed.

Further, **Kishimoto et al.** does not provide motivation to combine itself with the other references. While it is understood that lack of an explicit motivation or teaching will not preclude a finding of obviousness, *KSR v. Teleflex*, 127 S. Ct. 1727 (2007), the situation differs here, because one reading the patent would have to develop a motivation completely separate from, and above, that asserted in the cited art. The motivation of lowered power

consumption described by **Kishimoto et al.** is not a motivating factor for the current invention.

Instead, the motivation for both Claim 3 and Claim 6 is the ability to continuously view video (or other) signal content on a mobile phone while simultaneously viewing incoming signal information without significantly disrupting the user's view of the original signal. This is accomplished through the downscaling of a video signal to a first display area, and the incoming information being displayed in the newly formed second display area. Motivation to produce Claims 3 and 6 is not found within **Kishimoto et al.**. Thus, a person of ordinary skill in the relevant art would not read **Kishimoto et al.**, along with the previously cited references, to produce the current invention. As such, withdrawal of the Section 103(a) rejections of Claims 3 and 6 is respectfully requested, as these claims are believed to be in condition for allowance.

Claims 10 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Bum** in view of **Mizuta et al.** in further view of **Youngs et al.** (U.S. Patent No. 6,600,918 B1) and **Saarinen** (U.S. Patent Publication No. 2001/0011993 A1). Claim 18 is rejected as unpatentable under 35 U.S.C. § 103(a) as unpatentable over **Bum** in view of **Youngs et al.** (U.S. Patent No. 6,600,918 B1) and **Saarinen** (U.S. Patent Publication No. 2001/0011993

A1). Reconsideration in light of the following remarks regarding **Youngs et al.** and **Saarinen** is respectfully requested.

Youngs et al. discloses a wireless network which includes transmitting signals received through various sources including cable, television, satellite and radio. This reference does not disclose a process or method on how to receive the signal on the mobile hand set.

Saarinen discloses a device which can sense the relative positioning of the device to the earth, and will then transfer the stereo audio sound from speakers positioned appropriately to each orientation of the video. However, the **Saarinen** disclosure only includes stereo output, while the claimed invention allows one orientation to be monaural and the other to be stereophonic.

As such, these references do not in combination, either together or with **Bum** and/or **Mizuta et al.**, disclose each element of Claims 10, 14, and 18. The applicant respectfully requests that these Section 103 rejections also be withdrawn.

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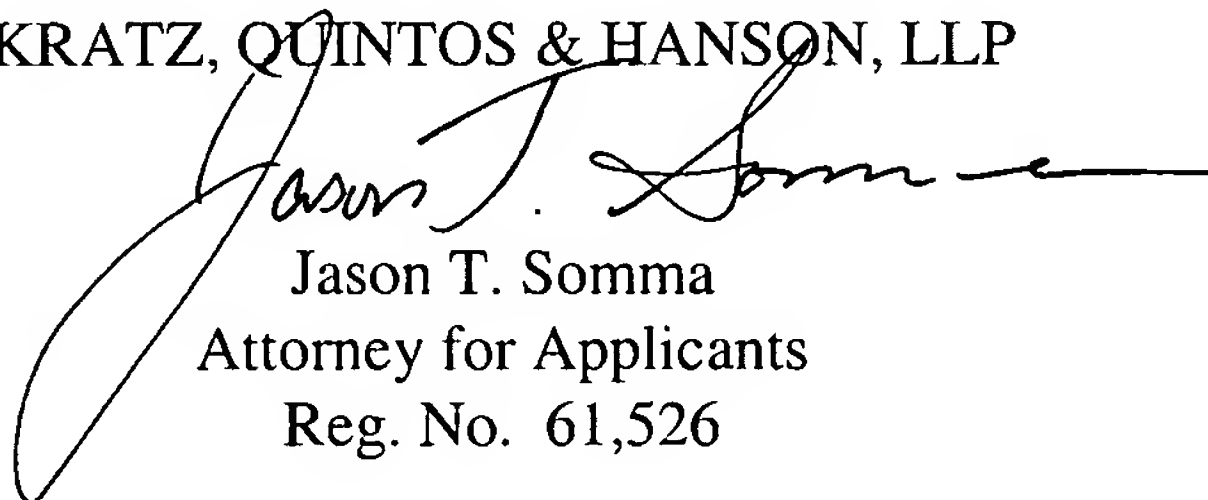
In view of the aforementioned remarks, claims 1 - 18 and claim 21 are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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